

REMARKS

This Amendment is submitted in response to the Office Action dated February 3, 2004, having a shortened statutory period set to expire May 3, 2004. Claims 1-43 are pending. No amendments to the claims have been made. Amendments to the specification have been made to identify cross-related applications. No new matter has been entered by these amendments.

Claim Rejections – 35 U.S.C. § 103(a)

In the present Office Action, Claims 1-7, 10-16, 19-25, 28-29, 32-34, 37-38, 40 and 42 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over *Dunaway, Jr.*, United States Patent Application Publication No. 20020026363 in view of *Ichikawa, et al.*, PCT No. WO9820641. Claims 8, 17 and 26 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over *Dunaway* in view of *Ichikawa* and further in view of *Moran* U.S. Patent No. 6,539,380. Claims 9, 18 and 27 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over *Dunaway* in view of *Ichikawa* and further in view of *Murray* U.S. Patent No. 6,392,668. Claims 30 and 35 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over *Dunaway* in view of *Ichikawa* and further in view of *Garney, et al.* U.S. Patent Application Publication No. 20020042891. Claims 31 and 36 have been rejected under 35 U.S.C. § 103(a), as being unpatentable over *Dunaway* in view of *Ichikawa* and further in view of *Ali* U.S. Patent No. 6,549,818. Those rejections are respectfully traversed and reconsideration of claims is requested.

With respect to exemplary Claim 1 in the present application, therein is recited the step of:

encrypting a selection of ingredients of a particular electronic recipe accessible at a particular web site wherein said encrypted selection of ingredients are decryptable at a food retailer server system associated with a food retailer that intends to pre-package said encrypted selection of ingredients;

It is argued on page 2-3 of the present Office Action that *Dunaway* shows a food retailer server system for a food retailer that “intends to pre-package said encrypted selection of

ingredients" in the summary of the invention and at paragraphs 60-67. However, this is not what *Dunaway* teaches. *Dunaway* describes an online data processing system to provide "remote culinary preparation services by personal chefs." (paragraph 9). While *Dunaway* describes a visitor website area to provide promotional information to potential clients, a client website area to permit remote culinary ordering remote culinary preparation services, a chef website area designed for individual chefs to obtain detailed information regarding assigned clients and a manager website area designed to provide access to managers (see Summary of the Invention), nothing within the summary of the invention or in paragraphs 60-67 describes a "food retailer" that accesses the network. More particularly, nothing within the cited sections of *Dunaway* describe a "food retailer" that intends to "pre-package said encrypted selection of ingredients." While the "home grocery delivery service" provides a selection of ingredients, the only pre-packaged ingredient such a home online grocery service provides are those which the end user orders directly. Nothing within *Dunaway* contemplates transmitting encrypted ingredients to the online grocer from the user "where said encrypted selection of ingredients is not accessible to said particular user" as is recited in exemplary Claim 1. However, the present invention teaches that such selection of ingredients is not accessible to the user.

It is further argued on page 3 of the present Office Action that *Dunaway* teaches that a particular user has a selection of ingredient that is accessible to the user. Moreover, the teaching of *Ichikawa* nowhere provides this missing suggestion or motivation. *Ichikawa* merely describes a standard encryption system, without any particular context or application relating to food preparation, ingredients, or food delivery. Neither *Dunaway*, nor *Ichikawa* provide any teaching to suggest the modification of *Dunaway* as suggested by the Examiner. In fact, *Dunaway* teaches away from the present invention by describing a system whereby the user (i.e., whether the chef or the chef's client) has to physically order the groceries from the home online service, and therefore must know what ingredients are being ordered. Nothing within either reference suggests encrypting the contents of a website such that the website user cannot access the contents, but a food retailer that receives an order from the user can.

Applicants respectfully submit that there must be some motivation or suggestion to combine these references or to modify *Dunaway* in a way suggested by the Examiner, and that

such suggestion is not provided in this prior art. Instead, Applicants respectfully submit that the Examiner has based the present rejection in hindsight of the present application. Here, the problem of presenting recipes to consumers, but keeping the ingredients of particular portions of the recipe confidential in order to enhance retailer food sales, has been uniquely addressed and solved in the present invention. The prior art neither contemplated the problem, nor provided any suggestion of a solution.

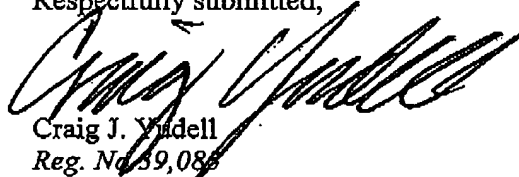
Applicants respectfully note the Federal Circuit case law on this point. For example, see *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). "As to applicants' claims to a large, orange plastic trash bag decorated with a jack o'lantern face, the PTO failed to establish *prima facie* obviousness based on prior art references showing (a) conventional trash bags, and (b) "children's art" with jack o'lantern faces on the outside of paper sacks (Holiday and Shapiro). See § 1563." "A showing of a suggestion, teaching, or motivation to combine prior teachings "must be clear and particular. . . . Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g. *C.R. Bard, Inc. v. M3 Sys., Inc.* ... (Fed. Cir. 1998) (describing 'teaching or suggestion or motivation [to combine]' as an 'essential evidentiary component of an obviousness holding'); *In re Rouffet* ... (Fed. Cir. 1998) ('the Board must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them'); *In re Fritch* ... (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination 'only by showing some objective teaching [leading to the combination]'); *In re Fine* ... (Fed. Cir. 1988) (evidence of teaching or suggestion 'essential' to avoid hindsight); *Ashland Oil, Inc. v. Delata Resins & Refractories, Inc.* ... (Fed. Cir. 1985) (district court's conclusion of obviousness was error when it 'did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination'). See also *Graham*, 383 U.S. at 18, ... 148 USPQ at 467 ('strict observance' of factual predicates to obviousness conclusion required)."" "We do not 'pick and choose among the individual elements of assorted prior art references to recreate the claimed invention,' but rather, we look 'some teaching or suggestion the references to support their use in their particular

claimed combination.” See also, *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991). “Although a prior art device “may be capable of being modified to run the way [the patent applicant’s] apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). “However, the test of whether it would have been obvious to select specific teachings and combine them as did the Applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention.” *In re Dance*, 160 F.3d 1339, 48 USPQ2d 1635 (Fed. Cir. 1998).

CONCLUSION

Applicants respectfully submit that neither *Dunaway*, nor *Ichikawa*, or any combination thereof, show or suggest the steps of encrypting ingredients to be decrypted by a "*food retailer server system associated with the food retailer that intends to pre-package said encrypted selection of ingredients*" and that further transmits an electronic recipe to a user that contains a portion that is encrypted "*such that said particular electronic recipes distributed to said particular user where said encrypted selection of ingredients is not accessible to said particular user,*" as is recited in exemplary Claim 1. Consequently, Applicants respectfully request reconsideration of the rejection of Claim 1 in the present Application. For the same reasons as given above with respect to exemplary Claim 1, Applicants respectfully submit that neither *Dunaway*, nor *Ichikawa*, nor any combination thereof shows or suggests the remaining pending claims in the present application and respectfully request reconsideration of those claims as well.

Respectfully submitted,



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